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09/498,363	02/04/2000	Yves Naoumenko	1247-0851-6V	8719

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Oblon Spivak McClelland Maier & Neustadt PC  
Fourth Floor  
1755 Jefferson Davis Highway  
Arlington, VA 22202

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 17

Application Number: 09/498,363  
Filing Date: February 04, 2000  
Appellant(s): NAOUMENKO ET AL.

\_\_\_\_\_  
Gregory J. Maier  
For Appellant

**MAILED**

NOV 20 2002

**GROUP 1700**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 10, 2002.

***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

***Summary of Invention***

The summary of invention contained in the brief is correct.

***Issues***

The appellant's statement of the issues in the brief is correct.

***Grouping of Claims***

The rejection of claims 1-7 and 10-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

***Prior Art of Record***

5,132,162	DE PAOLI	7-1992
5,137,770	ROTHER	8-1992

***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections – 35 USC § 103(a)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-19 are rejected under 35 U.S.C. 103(a) as being obvious over De Paoli (U.S. 5,132,162) in view of Rothe et al (U.S. 5,137,770).

De Paoli teaches a laminated glazing for a window which includes two or more sheets of rigid glass and an interlayer material (abstract). The glazing can exhibit a structure with an offset edge to be able to be mounted in a known way that is flush with the body as applicant instantly claims (column 3, lines 52-54). The reference teaches that an adhesive may be added to the interlayer to cause adhesion to the rigid sheets (column 3, lines 58-60).

The difference between the reference and the application is that the reference does not teach that a cement element can be adhered to the intermediate element for securing the glazing to the body or that the intermediate element is made of aluminum, stainless steel, epoxy or phenolic, unsaturated polyester resin containing reinforcement

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fillers. Rothe teaches the benefit of adding cement to a laminated glazing having glass panes for improvement of water tightness (column 1, lines 26-29. This is a conventional application as explained by Rothe in paragraphs 2-4 of column 1. Rothe also teaches that the intermediate element can be made of metals such as aluminum and steel (column 11, lines 1-6). The Rothe reference further includes the use of glass fiber strengthened plastics as reinforcing materials. Adhesive is also used in Rothe to adhere the cement to the other layers. The laminated glazing of either Rothe or De Paoli can be applied to windows, such as those in automobiles or plane cockpits. The intermediate element of Rothe shows the same intermediate elements as applicant claims and provides the same tensile strength as instantly claimed.

It would have been obvious to one of ordinary skill in the art to make the glazing of De Paoli provided with the intermediate element and cement of Rothe because Rothe shows the use of the cement to be conventional and shows it is used for improving the water tightness. It is also obvious to use the intermediate elements in Rothe in place of those used by De Paoli as those cited are conventional and the benefits of using them are well known.

### ***Response to Argument***

#### **Issue 1**

Appellant maintains that it would not have been obvious to one skilled in the art to combine the teachings of De Paoli and Rothe et al. This is not true because De Paoli in view of Rothe teaches a laminated glazing for a window which includes two or more sheets of rigid glass and an interlayer material (abstract) where the glazing can exhibit a

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structure with an offset edge to be able to be mounted in a known way that is flush with the body as applicant instantly claims (column 3, lines 52-54). De Paoli teaches that an adhesive may be added to the interlayer to cause adhesion to the rigid sheets (column 3, lines 58-60). The Rothe reference further includes the use of glass fiber strengthened plastics as reinforcing materials where adhesive is used to adhere the cement to the other layers. The laminated glazing of either Rothe or De Paoli can be applied to windows, such as those in automobiles or plane cockpits. Furthermore, De Paoli discloses two sheets held together by an interlayer made of polyvinyl butyral or polyurethane (column 3, lines 31-40). This interlayer of De Paoli is used as an adhesive because it holds the two sheets together. Appellant maintains Rothe et al does not disclose first and second transparent sheets, in which the first sheet is offset in relation to the second sheet to form an exposed edge portion of the first sheet because there is no offset in Rothe et al whatsoever. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, In response to applicant's argument that there is no offset in Rothe et al whatsoever, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*,

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642 F.2d 413, 208 USPQ 871 (CCPA 1981). De Paoli teaches a laminated glazing for a window which includes two or more sheets of rigid glass and an interlayer material (abstract) where the glazing can exhibit a structure with an offset edge to be able to be mounted in a known way that is flush with the body as applicant instantly claims (column 3, lines 52-54). Appellant maintains Rothe et al is not even relevant to the problem which the invention seeks to overcome – reduced shock resistance for a glazing having such an exposed edge. It does not matter that the reference does not expressly state that Rothe is not relevant to the problem. The glass structure of Rothe can provide the same features, absent any evidence to the contrary. Examiner contends that this statement is directed to intended use, which is given little patentable weight. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Appellant maintains there is no teaching or suggestion in De Paoli that the flexible interlayer is an intercalated adhesive layer binding the two rigid sheets of glass. The De Paoli reference meets this requirement because De Paoli teaches that an adhesive may be added to the interlayer to cause adhesion to the rigid sheets (column 3, lines 58-60). The Rothe reference further includes the use of glass fiber strengthened plastics as reinforcing materials

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where adhesive is used to adhere the cement to the other layers. The laminated glazing of either Rothe or De Paoli can be applied to windows, such as those in automobiles or plane cockpits. Furthermore, De Paoli discloses two sheets held together by an interlayer made of polyvinyl butyral or polyurethane (column 3, lines 31-40). This interlayer of De Paoli is used as an adhesive because it holds the two sheets together. Appellant maintains there is no teaching in De Paoli that the flexible interlayer would extend over the offset edge. De Paoli teaches an offset edge which can be mounted in a known way in column three. So one of ordinary skill in the art would understand how to mount the structure in an offset manner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

Lawrence Ferguson *LF*  
November 15, 2002

Conferees  
Cynthia Kelly *CHK*  
Bruce Hess

*BHH*

Oblon Spivak McClelland Maier & Neustadt  
Fourth Floor  
1755 Jefferson Davis Highway  
Arlington, VA 22202

*CyH HKW*